

REMARKS/ARGUMENTS

Favorable consideration of this application in light of the following discussion is respectfully requested.

Claims 1, 3-7, 12, 14, 17, and 18 are pending in this application. Claims 2, 8-11, 13, 15, and 16 were previously canceled without prejudice or disclaimer.

The outstanding Official Action presents a rejection of Claims 1, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen (apparently U. S. Patent No. 6,055,570 instead of “60555070” as incorrectly listed in the outstanding Action) in view of Criss et al. (apparently U. S. Patent No. 6,735,434, hereinafter Criss, instead of U. S. Published Patent Application No. 2002/012335 as incorrectly listed in the rejection¹), and a rejection of Claims 3-7, 12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen (again incorrectly listed, this time as 60555070) in view of Nodoushani et al. (U. S. Patent No. 6,144,849, Nodoushani).

Before turning to the outstanding rejections, the need to correct the incorrect reference numbers used in the outstanding Action is again called to the attention of the U.S. Patent & Trademark Office (USPTO). It is respectfully submitted that the incorrect reference numbers listed in the outstanding Action need to be corrected.

Turning to the rejection of Claims 1, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen in view of Criss, it is again noted that while Nielsen teaches that a user can monitor changes to information located on a network by registering with an update monitor service, Nielsen does not teach transmitting an update notification signal to any of

¹ The only “Criss et al.” document listed on the PTO-892 accompanying the Action mailed June 29, 2005, is U. S. Patent No. 6,735,434. The citations of col. 2, lines 55-67 (at page 3 of the outstanding Action) and col. 2, lines 55-67) of Criss further appear to relate to these portions as found in U. S. Patent No. 6,735,434 and not to corresponding portions in U. S. Patent Application Publication No. 2002/0123335, which is incorrectly listed as the reference number corresponding to Criss at page 2 of the outstanding Action. The actual named inventor associated with this published patent application (2002/0123335) is Luna, not Criss. Further, this Luna reference (2002/0123335) is noted at page 9 of the Action mailed June 29, 2005, to be made of record and to not be relied upon. Accordingly, Luna (U. S. Patent Application Publication No. 2002/0123335) is not treated further in this response.

the disclosed user computers to inform these user computers that the information being monitored has been updated. Instead, and as specifically noted relative to col. 5, lines 6-8, in the last response, each user must login to the service, and “[u]pon successful login, a list of those subscribed sites that have changed since his last visit to the monitor page is displayed to the user.”

The outstanding Action appears to suggest that instead of considering this actual disclosed update monitor service embodiment of Nielsen and the associated functions performed thereby, it is permitted to simply consider the broad summary of the invention statements at col. 2, lines 39-67, of Nielsen without regard to any of the actual embodiments taught by Nielsen. However, controlling precedent does not permit such an approach.

In this last regard, and as noted at page 9 of the last response relative to the *Kotzab* decision (217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)) “the [reference] statements cannot be viewed in the abstract. Rather they must be considered in the context of the teaching of the entire reference.” This was not new law, note *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) requiring “a fair reading of the prior art reference as a whole,” and *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965) noting that “it is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” Thus, the attempt to take broad statements from the “SUMMARY OF THE INVENTION” of Nielson out of the context of description of only disclosed embodiment of the “update monitor service” (as to actual operations performed as described at col. 5, lines 6-8), is clearly without merit.

The PTO is called upon to cite the authority it relies upon at the top of page 2 of the outstanding Action that provides the USPTO to limit consideration of the teachings of Nielsen to just the parts of col. 2 noted in the outstanding Action. This is further relevant

because these summary statements are clearly not detailed descriptions of the manner and means that achieve the stated objectives, just summaries of different aspects of the inventions that are only fully disclosed as to the “DESCRIPTON OF THE PREFERRED EMBODIMENT” that starts at col. 4, line 60.

In this regard, it is clear, for example, that the statements at col. 2 lines 46-53 relate to incomplete summaries of system connections and operations, not to the actual manner that the listed “update monitor service server” will obtain the suggested “information about changes in content of information stored in one or more content servers” or how this information is provided to the user computers. As noted at the bottom of page 8 of the last response:

Therefore, the above-noted teachings of col. 5, lines 6-8, as well as those of col. 7, lines 4-30 and col. 9, lines 10-30, make it clear that the mechanism for “providing” this information does not involve the Claim 1 required “transmitting an update notification signal indicating that said contents have been updated” to the user computers to notify them as to these updates. In the system actually taught by Nielsen, an update manager (a person or an automated process) is provided as to each monitored site and does the actual monitoring for changes. This update manager also transmits the only thing that can be reasonably called an “update notification signal,” but this update notification is transmitted to the update monitor service acting as a centralized collecting point and not to the “user” as Claim 1 requires. See col. 6, lines 6-10. The user computers can only obtain this information from the monitor service upon the above-noted successful login to the monitor service.

The requirement of MPEP §707.07(f) as to noting each of the arguments made as to traversing a repeated rejection and answering the substance thereof has not been followed as to these arguments or those raised as to the improper omission of any analysis of the teachings relied upon required under the *Gechter* decision that was cited on page 9 of the last response as follows:

In addition, the required analysis of the base Claim 1 recited “means” and associated functions has not been performed. In this regard, the PTO reviewing court recently emphasized that conclusory findings that omit analysis as to “means” claim limitations are improper in Gechter v. Davidson 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) as follows:

In addition, the [PTO] never construed the scope of the structures disclosed in the specification for the claimed "receiving means," nor did the [PTO] expressly find that the "receiving means" disclosed in the specification was structurally equivalent to that embodied in [the reference]. Moreover, the [PTO] also failed to define the exact function of the receiving means, as well as to find that [the reference] disclosed the identical function. [Emphasis added, citation omitted.]

Besides failing to reasonably teach the Claim 1 "notifying means" and any of its functions, it is clear that Nielsen also fails to teach, among many things, the Claim 1 "storing means" and any of its functions.

Moreover, the relied upon teaching at col. 2, lines 39-45, of Nielsen relates to "a process running on the computer for determining when information at a network address has changed." This is not stated to be used with the "update monitor service server" treated at col. 2, lines 46-53 that will "provide information to one or more user computers about changes in changes in content of information stored on one or more content servers." Thus, there is an open question as to how the "update monitor service server" obtains notification of any change. In this regard, col. 8, lines 55-60, of Nielsen suggest that information as to changes comes from email messages from an update manager of the particular URL being monitored. On the other hand, the Claim 1 "notifying means" has to be "responsive to said monitoring processing means" as to then "transmitting an update notification signal indicating that said contents have been updated." There is no disclosure that the receipt of any update email message from an update manager will cause any transmission of any update notification message to anything.

Thus, it appears that the outstanding Action is relying on conjecture or unfounded assumptions in suggesting that Nielsen teaches a computer performing as the Claim 1 "monitoring processing means" (as set forth at col. 2, lines 39-45) and that this "monitoring processing means" is taught by Nielsen to trigger an update monitor service server to act as

the Claim 1 “notifying means responsive to said monitoring processing means” and to provide change information to the user computers (as set forth at col. 2, lines 46-53).

However, this is clearly a modification of the actual teachings found at col. 2, lines 46-53 and such a modification to actual reference teachings using unfounded assumptions and/or speculation is improper. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”).

Besides resorting to speculation and assumption as to apparently suggesting that col. 2, lines 39-45 of Nielson teach the Claim 1 “monitoring means” while col. 2, lines 46-53 of Nielsen teach the Claim 1 “notifying means responsive to said monitoring processing means,” the outstanding Action further resorts to conjecture and or assumption as to suggesting that some unidentified part of col. 2, lines 39-67 actually teaches the function of “transmitting” set forth by Claim 1 as to how the “update notification signal indicating that said contents have been updated” is provided.

Col. 2, lines 46-53 simply note that the monitor server will “provide information to one or more user computers about changes in content of information stored on one or more content servers,” (emphasis added) not how this is provided. Also, lines 54-61 make a parallel suggestion as to a step of “providing information to one or more users about changes in content of information stored on one or more network servers.” What does not appear here, or elsewhere in Nielsen, is a teaching of the monitor server actually “transmitting an update notification signal” in response “to said monitoring processing means” (emphasis added).

As noted above and in the last response, the system actually taught by Nielsen has an update manager (a person or an automated process) at each monitored site that does the actual monitoring for changes. This update manager also transmits the only thing that can be reasonably called an “update notification signal,” but this update notification is transmitted to the update monitor service acting as a centralized collecting point and not to the “user” as Claim 1 requires. See col. 6, lines 6-10. The user computers can only obtain this information from the monitor service upon the above-noted successful login to the monitor service. There is no PTO analysis as to how these completely dissimilar reference “means,” can be said to be structurally equivalent to the Claim 1 storing means, monitoring processing means, and notifying means or the required explanation of how the Nielsen functions disclosed at the relied upon col. 2 sections are identical to the functions claimed as to each of these means, as the above noted *Gechter* requires.

The last response further noted many other deficiencies as to the repeated rejections appearing in the outstanding Action. As these traversals have not been answered as to these repeated rejections in complete disregard of the dictates of MPEP §707.07(f), they are repeated in hopes of obtaining the required MPEP §707.07(f) response as follows:

To whatever extent that Criss can be said to teach mobile terminals as part of a radio telephone communication network, Criss cannot be said to cure the above-noted inadequacies in Nielsen. In this regard, it is clear that the system of Criss does not teach or suggest, among other elements, the base Claim 1 “notifying means” and its functions or the base Claim 1 “storing means” and its functions as the operation taught by Criss does not require these elements for the same reason that the system of Nielsen does not. The system of Criss is like the system of Nielsen in “providing” information from a central source to peripheral terminals that have themselves established contact with that source. In order to secure software updates from a Criss base station, the Criss mobile terminals must contact that base station, because the base station does not send them notification that it contains an update that they requested just as the monitor service of Nielsen does not notify the users there of updates that have been made.

Therefore, there is no teaching or suggestion in Criss of the base Claim 1 required “notifying means” and its functions or the base Claim 1 “storing

means” and its functions just as there was none in Nielsen. Accordingly, as not all of the subject matter of base independent Claim 1 can be said to be taught by Nielsen and Criss taken together, no *prima facie* case of obviousness² can be reasonably asserted to be present and this rejection should be withdrawn as being clearly improper for this reason alone.

Also, the required explanation as to what would have led the artisan to select the Criss wireless communication system to modify the internet web page based monitoring system of Nielsen is clearly lacking. See *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and the requirement there for the PTO to “explain the reasons one of ordinary skill would have been motivated to select the references and to combine them to render the claimed invention obvious.” Establishing proper motivation to combine references further requires more than unsupported generalizations like the assertion of an “improved hybrid communication system” as at the middle of page 3 of the outstanding Action. The need for specificity pervades the case law. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”) and *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) requiring the showing as to motivation to be clear and particular.

Accordingly, as the prerequisites to establishing a valid *prima facie* case of obviousness have not been followed, no valid rejection has been made as to independent Claim 1. Consequently, withdrawal of the rejection of independent Claim 1 as being unpatentable over Nielsen in view of Criss is respectfully requested.

In addition, as Claims 17 and 18 depend on Claim 1 directly or indirectly, these claims are believed to clearly patentably define over Nielsen and/or Criss taken alone or together in any proper combination for at least the reasons noted above as to parent independent Claim 1. Moreover, as Claims 17 and 18 add further features not taught or suggested by either Nielsen and/or Criss taken alone or together in any proper combination, Claims 17 and 18 are further respectfully submitted to be patentable over these applied references for this reason as well.

Just as the required analysis of the base Claim 1 recited “means” and their associated functions was not properly performed as to base Claim 1 subject matter, it has not been properly performed as to that of base Claim 3 subject matter. In this respect, Claim 3 is like Claim 1 in reciting a “notifying means for notifying a user with an update notification signal” that has not been properly analyzed and shown to be taught by either Nielsen or Nodoushani, the references relied on to reject base independent Claim 3.

² It is well established that a *prima facie* case of obviousness requires that all claim limitations be considered and demonstrated to be taught or suggested by the prior art, see MPEP §2143.03.

Besides neither Nielsen nor Nodoushani teaching or suggesting the Claim 3 “notifying means,” it is also clear that these references do not teach or suggest the Claim 3 “radio transmitting means for transmitting the acquisition instructing signal to a prescribed information processing apparatus, said prescribed information processing apparatus responding to the received acquisition instructing signal to instruct acquisition of said contents that have been updated.”

In this regard, while the outstanding Action suggested that col. 4, lines 60-67 and/or col. 5, lines 1-5 and 21-30 of Nielsen somehow taught or suggested the Claim 3 “radio transmitting means,” there was no factual support for the assertion at the noted portions of Nielsen.

However, col. 4, lines 60-67 and col. 5, lines 1-5 of Nielsen relate to how the user would log in to the monitor service web page to obtain initial notification of whether or not any changes have occurred as to sites being monitored for changes. Independent Claim 3, on the other hand, requires that the user has already been notified of such changes and that then the user generates the claimed “acquisition instructing signal” that will cause the claimed “prescribed information processing means” to provide for “instructing acquisition of said contents that have been modified.”

Similarly, col. 5, lines 21-30 of Nielsen are not teachings of what happens after the user has received notification of a change to contents being monitored. Instead, these teachings deal with how the user first subscribes to web sites he desires be monitored using the monitor page that he has properly logged into and an “add button.” While the possibility of a change to a monitored page is noted as possibly occurring between user visits at col. 5, lines 25-30 just suggest that the user will “see the name of the site listed after the initial login.”

Moreover, to whatever extent that Nodoushani can be said to teach mobile terminals as part of a radio telephone communication network, Nodoushani cannot be said to cure the above-noted inadequacies in Nielsen.

Also, just as the required specific explanation as to what would have led the artisan to select the Criss wireless communication system to modify the internet web page based monitoring system of Nielsen is clearly lacking, so is the presentation of specific reasons why the artisan would have been reasonably led to select the Nodoushani wireless communication system to modify the internet web page based monitoring system of Nielsen, much less any full explanation of the actual modification being proposed.

Accordingly, as the prerequisites to establishing a valid *prima facie* case of obviousness have not been followed, no valid rejection has been made as to independent Claim 3. Consequently, withdrawal of the rejection of independent Claim 3 as being unpatentable over Nielsen in view of Nodoushani is respectfully requested.

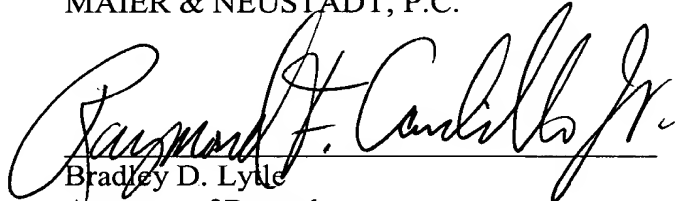
In addition, as Claims 4-7 all depend directly on Claim 3, these claims are believed to clearly patentably define over Nielsen and/or Nodoushani taken alone or together in any proper combination for at least the reasons noted above as to parent independent Claim 3. Moreover, as Claims 3-7 add further features not taught or suggested by either Nielsen and/or Nodoushani taken alone or together in any proper combination, Claims 3-7 are further respectfully submitted to be patentable over these applied references for this reason as well.

Moreover as independent Claim 12 is an apparatus claim that parallels independent Claim 3 using apparatus limitations instead of the "means" of independent Claim 3, and as independent Claim 14 is a method claim that parallels independent Claim 3 using method limitations instead of the "means" of independent Claim 3, Claims 12 and 14 are believed to patentably define over either Nielsen and/or Nodoushani taken alone or together in any proper combination for all the reasons noted above as to independent Claim 3.

As no further issues are believed to remain outstanding relative to this application, it is respectfully submitted that this application is clearly in condition for formal allowance, and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073
Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)

BDL/RFC/jmp